

### **REMARKS**

The paper is in response to the Office Action mailed September 10, 2008 ("the Office Action"). The foregoing amendment amends claims 1, 2, and 23-26. Claims 1-13 and 14-26 are now pending (claim 14 having been cancelled in a previous amendment). Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

#### **I. Rejection Under 35 U.S.C. §112, ¶1**

The Office Action rejects claims 1 and 23 under 35 U.S.C. §112, ¶1. Applicants respectfully traverse this rejection for at least the reason that the specification, including the drawings, the detailed description, and the original claims provide adequate written description.

According to MPEP §2163, "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention."

The Examiner appears to identify the broadband reflection layer 2 of the multiplex body 1 in Figure 1 as the claimed "substrate." *See Office Action*, p. 2 ("The closest drawing on record is Figure 1 wherein the lens '7' is clearly not in the substrate '2'.") However, the specification also describes an example embodiment having a planar substrate 43. *See* paragraph [0031] and Figures 2-5. Therefore, the Examiner's understanding of claims 1 and 23 appears to be based on an identification of reflection layer 2 as a "substrate" rather than planar substrate 43.

Because the specification adequately supports claims 1 and 23, Applicants respectfully request that Examiner withdraw the rejection of claims 1 and 23 under 35 U.S.C. §112, ¶1.

## **II. Rejection under 35 U.S.C §103(a)**

The Office action rejects claims 1-13, 15, and 18-26 under 35 U.S.C §103(a) over *Nosu et al.* (U.S. Patent No. 4,244,045) in view of *Naganuma* (U.S. Patent No. 6,515,776)<sup>1</sup> and rejects claims 16-17 under 35 U.S.C §103(a) over *Nosu et al.* in view of *Naganuma* in further view of *Sasaki et al.* (U.S. Patent No. 5,960,141).

Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." According to MPEP §2142, "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." Moreover, the Examiner must establish that the references teach or suggest each and every claim element or explain "why the difference(s)

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<sup>1</sup> The Office Action mistakenly referenced U.S. Patent No. 6,515,766, which is a patent issued to *Matama* entitled, "Photographic Photosensitive Material And Photographic Printing System." The Examiner apparently intended to reference U.S. Patent No. 6,515,776 to *Naganuma*. In the interest of providing an accurate record, Applicants respectfully request that the Examiner issue a new Notice of References Cited (Form PTO-892) that includes U.S. Patent No. 6,515,776 to *Naganuma*.

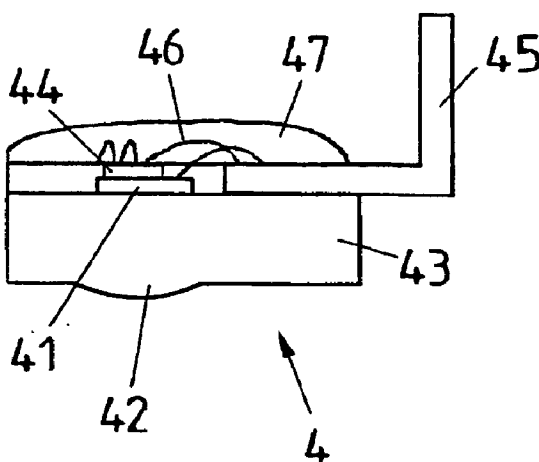
between the prior art and the claimed invention would have been obvious.”<sup>2</sup> The Office Action does neither.

Claim 1, as amended, recites:

- a first subassembly including a first optoelectronic transducer on a first side of a first substrate and an associated optical system having a first lens in a second side of the first substrate; and
- a second subassembly including a second optoelectronic transducer on a first side of a second substrate and an associated optical system having a second lens in a second side of the second substrate.

An example embodiment illustrating the components of a subassembly is illustrated in Figure 3 in the application (copied below). For example, Figure 3 depicts a subassembly 4 having an optoelectronic transducer 41 on a first side of a substrate 43 and an associated optical system having a lens 42 in a second side of the substrate 43.

FIG 3



<sup>2</sup> MPEP §2143.03 (“All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”); MPEP §2141.III (“The prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office

The Examiner rejected claim 1 based on a combination of *Nosu* and *Nagamuma*, but did not explicitly identify a substrate in either reference. In a previous Office Action the Examiner identified prisms 81-86 of *Nosu* as substrates.<sup>3</sup> See *Office Action* dated February 25, 2008, p. 3. However, Figure 15 of *Nosu* (cited by the February 25, 2008, Office Action) clearly illustrates that the lenses 41-46 are between the prisms 81-86 and the sensors 71-76. In contrast, claim 1 recites an arrangement in which "a first optoelectronic transducer [is] on a first side of a first substrate and... a first lens [is] in a second side of the first substrate."

Alternatively, it may be the case that the Examiner believes the "common substrate" 60 described in *Nosu* corresponds to the claimed first or second substrates. However, common substrate 60 is a single substrate and therefore cannot possibly constitute the claimed first and second substrates recited in claim 1. In addition, the substrate 60 is identified by the Examiner as the claimed "monolithic transparent body" (see Office Action, p. 3) and therefore cannot logically be part of a first or second subassembly "mounted adjacent to the second surface of the monolithic transparent body," as required by claim 1.

In connection with the foregoing points, Applicants note that the Examiner is on record in two previous Office Actions as stating that "Nosu does not teach that the optoelectronic transducer is supported by a substrate that includes a lens attached to the substrate." See Office Action dated January 5, 2007, p. 3, and Office Action dated June 8, 2006, p. 4. Therefore, if the Examiner now believes that first and second substrates are taught by *Nosu*, Applicants respectfully request that the Examiner **specifically point out where in Nosu such substrates are taught**. "When a reference is complex or shows or describes inventions other than that claimed by the Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 CFR 1.104 (emphasis added). Moreover, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the

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personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.")

<sup>3</sup> Applicants do not concede that a prism teaches or suggests a substrate.

opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." MPEP § 706 (emphasis added).

For at least the foregoing reasons, Applicants respectfully submit that claim 1 is patentable over the cited art. Claims 23 and 24 are also patentable for at least the same reasons. Amended claims 23 and 24, although of different scope, have generally similar elements as claim 1.

Moreover, *Sasaki*, relied on for its purported teachings related to features recited in dependent claims 16 and 17, fails to cure the deficiencies noted above with respect to the combination of *Nosu* and *Nagamuma*. Therefore, the dependent claims are also patentable for at least the same reasons.

### **Charge Authorization**

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

**CONCLUSION**

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 10th day of March, 2009.

Respectfully submitted,

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